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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/182,033	10/29/1998	DALE BURNS	2391	1559

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ROBERTS ABOKHAIR & MARDULA  
SUITE 1000  
11800 SUNRISE VALLEY DRIVE  
RESTON, VA 20191

EXAMINER

KAZIMI, HANI M

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/182,033

Applicant(s)

BURNS, DALE

Examiner

Hani Kazimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above claim(s) 30-37, 39-47 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. In view of the decision by the board of patents appeals and interferences filed on November 18, 2002, PROSECUTION IS HEREBY REOPENED. The rejections cited are as stated below:

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Status of Claims***

2. Of the original claims 1-22, claims 1, 2, 4, 5, 8, 9, 11, 12, 14, and 21 have been amended, and claims 23-29 have been added in the preliminary amendment filed on September 29, 1999. In the amendment filed on February 3, 2000, claims 1, 2, 4-9, 11-14, 18, 19, 21-24, and 29 have been amended. In the amendment filed on July 26, 2000, claims 1-29 have been canceled, and claims 30-39 have been added. In the amendment filed on February 21, 2001, claims 30, and 32 have been amended, and claims 40-49 have been added. Therefore, claims 30-49 are under

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prosecution in this application.

3. The Examiner acknowledges the decision by the board of patents appeals and interferences filed on November 18, 2002 and therefore withdraws the previous office action's objection to the specification and claim rejections under 35 U.S.C. § 112 1st paragraph regarding this matter. However, since the board of patents appeals and interferences affirmed the examiner's rejections of claims 30-37, 39-47 under 35 U.S.C. § 103, the examiner reopens prosecution to address claims 38, and 48.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or

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nonobviousness.

6. Claims 38 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger et al. (U.S. Patent No. 4,882,675) hereinafter "Nichtberger" in view of De Lapa et al. (U.S. Patent No. 4,882,675) hereinafter "De Lapa" and further in view of Christensen (U.S. Patent No. 6,035,280).

Claims 38, and 48, Nichtberger teaches an electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register (abstract) comprising:

a plurality of consumer identification means wherein each consumer identification is associated with a consumer (column 5, lines 1-16, and column 5, line 45 thru column 6, line 23);

a plurality of consumer accounts associated with said plurality of consumer identification means (column 11, lines 35-63, and column 17, line 49 thru column 18, line 43);

a database for storing information for each of said plurality of consumer accounts (column 29, lines 32-68);

at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's identification means so as to eliminate any need to present printed coupons at a checkout register (column 17, line 29 thru column 18, line 43);

at least one checkout register capable of collecting a consumer's purchase

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information, said register additionally being connected to said database (column 17, line 29 thru column 18, line 43);

means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means (column 17, line 29 thru column 18, line 43); and

means for updating said consumer's consumer account to reflect utilization of coupons (column 17, line 29 thru column 18, line 43), wherein one means for each consumer to enter unutilized coupon information from printed coupons provided for consumers to add unutilized coupon information into their consumer account (column 29, lines 56-68).

Nichtberger fails to teach that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account.

De Lapa teaches that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account (column 9, line 32 thru column 12, line 34).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Nichtberger to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account, because it greatly improves the efficiency of the system by substantially reducing redemption and

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clearing costs, reducing fraud by destroying paper coupons by the CDR unit once inserted and read, also, it would integrate currently used system into the invention (see Nichtberger column 29, lines 56-68).

Both Nichtberger and De Lapa fail to teach the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means.

Christensen teaches the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means (column 11, line 62 thru column 15, line 36).

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Nichtberger to include the use of Internet to review unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means, because it provides convenience to the user by allowing the user to access coupons of interest quickly by performing a word search, and review, select, and retrieve coupon information directly from the operations center (see Christensen column 13, lines 14-50).

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**

Hani.Kazimi

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May 30, 2003